

1 Evan S. Nadel (CA Bar No. 213230)
2 KILPATRICK TOWNSEND & STOCKTON LLP
3 *ENadel@kilpatricktownsend.com*
4 Two Embarcadero Center, Suite 1900
5 San Francisco, CA 94111
6 Telephone: (415) 576-0200
7 Facsimile: (415) 576-0300

8 Rita Weeks (CA Bar No. 232396)
9 *Rweeks@kilpatricktownsend.com*
10 Marc A. Lieberstein (admitted *pro hac vice*)
11 *MLieberstein@kilpatricktownsend.com*
12 KILPATRICK TOWNSEND & STOCKTON LLP
13 1114 Avenue of the Americas
14 New York, NY 10036
15 Telephone: (212) 775-8700
16 Facsimile: (212) 504-9566

17 *Attorneys for Plaintiff*
18 *Chippendales USA, LLC*

19
20 **UNITED STATES DISTRICT COURT**
21
22 **FOR THE CENTRAL DISTRICT OF CALIFORNIA**

23 CHIPPENDALES USA, LLC,
24 Plaintiff,

25 v.
26 JESUS "JESSE" BANERJEE, dba
27 EASEBE ENTERPRISES INC.,

28 Defendant.

Case No. 2:23-cv-03676-PA (PDx)
Judge: Hon. Percy Anderson

**PLAINTIFF'S MEMORANDUM OF
POINTS AND AUTHORITIES IN
SUPPORT OF ITS MOTION FOR
DEFAULT JUDGMENT AGAINST
DEFENDANT JESSE BANERJEE**

Hearing Date: August 21, 2023
Time: 1:30 p.m.
Courtroom: 9A

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7027

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	STATEMENT OF FACTS.....	2
A.	Procedural Background	2
B.	Plaintiff and its World-Famous CHIPPENDALES Brand.....	2
C.	Plaintiff's Rights In and Registrations for its Famous CHIPPENDALES Trademarks	3
D.	Defendant's Counterfeit and Infringing Goods.....	5
E.	Defendant's Infringing Services.....	6
F.	Defendant's Misrepresentations to the U.S. Patent and Trademark Office	6
G.	Defendant's Probate Action Concerning the CHIPPENDALES Brand	7
III.	ARGUMENT	8
A.	The <i>Eitel</i> Factors Favor Entry of Default Judgment	8
1.	Plaintiff Will Be Prejudiced Absent a Default Judgment	9
2.	Plaintiff's Complaint is Sufficiently Pled and Its Claims Are Meritorious.	10
a.	Plaintiff's Federal Claims for Trademark Infringement and Unfair Competition, and its California Claim for Unfair Competition.....	10
i.	Plaintiff's Protectable Ownership Interest in the CHIPPENDALES Marks.....	11
ii.	Defendant's Unauthorized Use of the CHIPPENDALES Marks Is Likely to Cause Confusion.....	11
b.	Plaintiff's Federal Counterfeiting Claim	12
c.	Plaintiff's Federal and State Law Dilution Claims.....	13
d.	Plaintiff's Declaratory Judgment Claim	14
3.	The Damages Sought By Plaintiff Favor Default Judgment	15
4.	No Dispute Exists As To Material Facts.....	16
5.	The Default Entered Against Defendant Did Not Result from Excusable	

1	Neglect	16
2	6. Defendant's Failure to Answer Makes a Decision on the Merits Impossible	17
3	7. Summary of the <i>Eitel</i> Factors.....	17
4	B. Plaintiff's Requested Remedies are Warranted, Authorized, and	
5	Substantiated.....	18
6	1. Plaintiff is Entitled to Injunctive Relief.....	18
7	2. Plaintiff is Entitled to a Declaratory Judgment.....	18
8	3. Plaintiff is Entitled to Statutory Damages.....	20
9	4. Plaintiff Is Entitled to Attorneys' Fees And Costs.....	21
10	IV. CONCLUSION	22
11	Local Rule 11-6.2 Certificate of Compliance.....	23
12		
13		
14		
15		
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17		
18		
19		
20		
21		
22		
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26		
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28		

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Benny v. Pipes</i> , 799 F.2d 489 (9th Cir. 1986)	8
<i>Century 21 Real Estate Corp. v. Sandlin</i> , 846 F.2d 1175 (9th Cir. 1988)	18
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<i>Derek Andrew, Inc. v. Poof Apparel Corp.</i> , 528 F.3d 696 (9th Cir. 2008)	20, 21
<i>DIRECTV, Inc. v. Hoa Huynh</i> , 503 F.3d 847 (9th Cir. 2007)	8, 9, 10
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<i>Jada Toys, Inc. v. Mattel, Inc.</i> , 518 F.3d 628 (9th Cir. 2008)	13
<i>Jesse Banerjee v. Chippendales USA, LLC</i> , Case No. 2:23-cv-03676-PA	15, 17, 22
<i>Kinsley Tech. Co. v. Ya Ya Creations, Inc.</i> , No. 2:20-CV-04310-ODW-KSx, 2022 WL 3908831 (C.D. Cal. Aug. 30, 2022)	10, 11
<i>KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.</i> , 543 U.S. 111 (2004)	11



1	<i>Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.,</i> 633 F.3d 1158 (9th Cir. 2011).....	13
3	<i>Levi Strauss & Co. v. Toyo Enter. Co.,</i> 665 F. Supp. 2d 1084 (N.D. Cal. 2009).....	9
5	<i>Louis Vuitton Malletier, S.A. v. Akanoc Sols., Inc.,</i> 658 F.3d 936 (9th Cir. 2011).....	12
7	<i>Nestle USA, Inc. v. Gunther Grant, Inc.,</i> No. CV-13-6754 MMM (ASX), 2014 WL 12558008 (C.D. Cal. May 13, 2014).....	12, 16
9	<i>Network Automation, Inc. v. Advanced Sys. Concepts, Inc.,</i> 638 F.3d 1137 (9th Cir. 2011).....	10
11	<i>PepsiCo, Inc. v. Cal. Sec. Cans,</i> 238 F. Supp. 2d 1172 (C.D. Cal. 2002).....	8, 17
13	<i>Philip Morris USA Inc. v. Castworld Prods., Inc.,</i> 219 F.R.D. 494 (C.D. Cal. 2003)	9, 17
15	<i>Phillip Morris USA Inc. v. Shalabi,</i> 352 F. Supp. 2d 1067 (C.D. Cal. 2004).....	12
17	<i>Rio Props., Inc. v. Rio Int'l Interlink,</i> 284 F.3d 1007 (9th Cir. 2002).....	21
18	<i>Rolex Watch U.S.A., Inc. v. LSM Watch, Inc.,</i> No. CV 21-1612-PSG, 2022 WL 3575771 (C.D. Cal. June 7, 2022).....	21
20	<i>Tech. LED Intellectual Prop., LLC v. Recogi, LLC,</i> No. 18-cv-3827, 2019 WL 2716610 (N.D. Cal. June 27, 2019).....	16
22	<i>Vietnam Reform Party v. Viet Tan - Vietnam Reform Party,</i> 416 F. Supp. 3d 948 (N.D. Cal. 2019).....	10, 14
24	<i>Wecosign, Inc. v. IFG Holdings, Inc.,</i> 845 F. Supp. 2d 1072 (C.D. Cal. 2012).....	17
26	<i>YYGM S.A. v. Palco Clothing, Inc.,</i> No. CV 15-9181 PA, 2016 WL 7655755 (C.D. Cal. June 20, 2016) (Anderson, J.)	21
28		

1 **Statutes**

2	15 U.S.C. § 1065.....	3, 4, 5
3	15 U.S.C. § 1114.....	2
4	15 U.S.C. § 1114(1).....	2
5	15 U.S.C. § 1115(b).....	11
6	15 U.S.C. § 1117.....	16
7	15 U.S.C. § 1117(a)	21
8	15 U.S.C. § 1117(c)	20
9	15 U.S.C. § 1121.....	8
10	15 U.S.C. § 1125(a)	2
11	15 U.S.C. § 1125(c)	2, 13
12	15 U.S.C. § 1127.....	12
13	28 U.S.C. §§ 1331, 1338(a) & 1338(b)	8
14	28 U.S.C. § 1441(b).....	15
15	28 U.S.C. § 2201.....	14
16	Cal. Bus. & Prof. Code §§ 14247, 14330.....	18
17	Cal. Bus. & Prof. Code § 14330	2, 13
18	Cal. Bus. & Prof. Code § 17200	2
19	California Business & Professions Code § 17200 <i>et seq.</i>	20
20	Lanham Act.....	16, 18, 20, 21
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1 **Other Authorities**

2	Fed. R. Civ. P. 55(b)(2) and C.....	1
3	Federal Rule of Civil Procedure 55(a).....	2
4	Federal Rule of Civil Procedure 55(b)	8
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1 Pursuant to Fed. R. Civ. P. 55(b)(2) and C.D. Cal. L.R. 55-1, Plaintiff
 2 Chippendales USA, LLC submits this Memorandum of Points and Authorities in
 3 support of its Motion for Default Judgment against Defendant Jesse Banerjee.

4 **I. INTRODUCTION**

5 Due to Defendant's default, entered on June 20, 2023 (Dkt. 22), the
 6 allegations in Plaintiff's Complaint (Dkt. 1) are deemed admitted. There is thus no
 7 dispute that Plaintiff owns and operates the world-famous CHIPPENDALES
 8 entertainment brand that produces Broadway-style, burlesque dance shows
 9 worldwide or that Defendant Jesse Banerjee has been offering for sale counterfeit
 10 clothing and hats—along with other types of infringing goods and services—under
 11 the CHIPPENDALES trademarks. Plaintiff seeks an injunction to stop Defendant
 12 from continuing this unlawful conduct and a declaratory judgment recognizing
 13 Plaintiff's ownership of and exclusive rights to the CHIPPENDALES trademarks.
 14 This is critical because Defendant has made unauthorized and deceptive filings with
 15 the U.S. Patent and Trademark Office in an effort to assume control over Plaintiff's
 16 federal trademark registrations, and he also filed a legal action against Plaintiff
 17 seeking to transfer ownership of the trademarks to himself.

18 The Clerk of Court entered Defendant's default in this action after he failed to
 19 respond to the Complaint despite being served with process. Plaintiff now brings
 20 this Motion requesting that the Court enter a default judgment against Defendant
 21 that includes: (a) a declaratory judgment recognizing Plaintiff's sole and exclusive
 22 rights in and ownership of the CHIPPENDALES trademarks; (b) a permanent
 23 injunction against Defendant's infringement and counterfeiting; and (c) an award of
 24 statutory damages and Plaintiff's attorneys' fees and costs, consistent with the relief
 25 requested in its Complaint.

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1 **II. STATEMENT OF FACTS**

2 **A. Procedural Background**

3 On May 12, 2023, Plaintiff filed its Complaint against Defendant asserting
 4 claims for: (1) declaratory relief as to Plaintiff's ownership of the CHIPPENDALES
 5 trademarks; (2) federal trademark infringement, 15 U.S.C. § 1114(1); (3) trademark
 6 counterfeiting, 15 U.S.C. § 1114; (4) federal unfair competition 15 U.S.C. §
 7 1125(a); (5) federal trademark dilution, 15 U.S.C. § 1125(c); (6) California
 8 trademark dilution, Cal. Bus. & Prof. Code § 14330; and (7) unfair business
 9 practices under Cal. Bus. & Prof. Code § 17200. Complaint (Dkt. 1). Defendant
 10 was served with the Summons and Complaint in this action by USPS first class mail
 11 and by leaving copies at Defendant's dwelling with someone of suitable age and
 12 discretion on May 21, 2023. *See* Declaration of Evan S. Nadel in Support of
 13 Plaintiff's Motion for Entry of Default Judgment Against Defendant Jesse Banerjee,
 14 filed concurrently with Plaintiff's Motion ("Nadel Decl.") ¶ 5. Defendant was
 15 required to respond to the Complaint by June 12, 2023. *Id.* ¶ 6.

16 Defendant failed to file a responsive pleading. *Id.* ¶ 7. Therefore, pursuant to
 17 Federal Rule of Civil Procedure 55(a), the Clerk of Court granted Plaintiff's request
 18 for default and entered a default against Defendant on June 20, 2023. Dkt. 22.

19 **B. Plaintiff and its World-Famous CHIPPENDALES Brand**

20 Plaintiff owns and operates the world-famous CHIPPENDALES
 21 entertainment brand that produces Broadway-style, burlesque shows worldwide.
 22 Compl. ¶ 2. The CHIPPENDALES performance troupe was established in Los
 23 Angeles in 1979 as the world's first all-male dance act and immediately became a
 24 cultural phenomenon, which quickly led to the opening of clubs in other U.S. cities,
 25 as well as touring troupes performing in the U.S. and overseas. *Id.* ¶¶ 13-14. The
 26 revue's immense popularity also spawned the creation of a vast array of licensed
 27 merchandise such as clothing and annual calendars. *Id.* ¶ 14. Today the



1 CHIPPENDALES performance troupe entertains audiences from its flagship
 2 location at the CHIPPENDALES Theater in Las Vegas, as well as in U.S. and
 3 international venues visited by its touring productions. *Id.* ¶ 15.

4 **C. Plaintiff's Rights In and Registrations for its Famous
 5 CHIPPENDALES Trademarks**

6 Plaintiff is the sole owner of the CHIPPENDALES business and brand, which
 7 it acquired in 2000. Compl. ¶ 17. Through a March 30, 2000 Asset Purchase
 8 Agreement, Plaintiff acquired from CLP Tour, Ltd. (“CLP”), the prior owner of the
 9 brand, the CHIPPENDALES business, along with the famous CHIPPENDALES
 10 trademarks and the underlying goodwill represented by the marks. *Id.* ¶ 39.
 11 Plaintiff obtained all of the common law rights in the CHIPPENDALES trademarks,
 12 as well as the following federal registrations and applications: Reg. Nos. 1,197,438;
 13 1,211,893; and 1,330,855; Ser. Nos. 75/087,380 75/087,377; 75/087,376; and
 14 75/087,375. *Id.* The trademark assignment transferring ownership of these
 15 registrations and applications from CLP to Plaintiff was recorded with the U.S.
 16 Patent and Trademark Office on July 7, 2000. *Id.* ¶ 41.

17 Through Plaintiff's and its predecessors in interest's extensive use of the
 18 CHIPPENDALES marks over the last 45 years, Plaintiff has developed extensive
 19 common law rights in the marks for a wide range of products and services. *Id.* ¶ 20.
 20 In addition, Plaintiff owns numerous valid federal registrations on the Principal
 21 Register of the U.S. Patent and Trademark Office for the CHIPPENDALES mark
 22 and its CHIPPENDALES & Bow Tie Design mark for many types of goods and
 23 services, as shown below:

Trademark	Reg. No./ Reg. Date	Goods/Services	Date of First Use
CHIPPENDALES *Registration has become incontestable pursuant to 15 U.S.C. § 1065	1197438 6/8/82	41: Entertainment services, namely, male dance exhibitions.	12/1/78

1	CHIPPENDALES *Registration has become incontestable pursuant to 15 U.S.C. § 1065	1330855 4/16/85	16: Calenders, playing cards, posters.	7/3/81
2	CHIPPENDALES *Registration has become incontestable pursuant to 15 U.S.C. § 1065	2802430 1/6/04	9: Series of DVDs featuring music and male nightclub entertainers.	1987
3	CHIPPENDALES *Registration has become incontestable pursuant to 15 U.S.C. § 1065	3127649 8/8/06	16: Party supplies, namely, paper napkins; pin-ups, namely, flat, cardboard poster-like cutouts of men with adjustable hands, arms, and legs. 25: Clothing, namely headwear, hats, tank tops, t-shirts, long sleeve t-shirts, sweatshirts, shorts, nightshirts and undergarments. 41: Entertainment services, namely, live theatrical and musical floor shows provided at night clubs and theaters. 45: Providing online greeting cards via the internet.	16: 7/31/10 26: 2/7/00 41: 7/3/81 45: 2/19/06
4	CHIPPENDALES *Registration has become incontestable pursuant to 15 U.S.C. § 1065	3690717 9/29/09	43: Waiter services for serving drink; bar services.	2/1/05
5	CHIPPENDALES *Registration has become incontestable pursuant to 15 U.S.C. § 1065	3981590 6/21/11	10: Electric massage applicants, namely, electric vibrating massager.	10/1/10
6	CHIPPENDALES & Bow Tie Design  CHIPPENDALES	5203733 5/16/17	10: Electric massage appliances, namely, electric vibrating massager. 16: Calendars and paper goods, namely, pin-ups, namely, flat, cardboard, poster-like cutouts of men with adjustable hands, arms and legs. 21: Barware, namely, shotglasses. 25: Clothing, namely, headwear, hats, tank tops; t-shirts, long sleeve t-shirts, sweatshirts, shorts, nightshirts and undergarments.	10: 10/15 16: 10/15 25: 10/15 41: 9/15

1		41: Entertainment services, namely, live theatrical and musical floor shows provided at night clubs and theaters.	
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4 Compl. ¶ 20 & Exhibit 1.

5 Plaintiff's federal registrations for its CHIPPENDALES word marks (namely,
6 U.S. Reg. Nos. 1197438; 1330855; 2802430; 3127649; 3690717; and 3981590) are
7 uncontestable under 15 U.S.C. § 1065. Compl. ¶ 23.

8 Since acquiring the CHIPPENDALES business in 2000, Plaintiff has
9 continuously and exclusively used the foregoing marks (collectively, the
10 "CHIPPENDALES Marks") in the United States. Compl. ¶¶ 42-43. Therefore,
11 independently of the rights Plaintiff acquired in 2000, Plaintiff owns the
12 CHIPPENDALES Marks through continuous, exclusive use of them for over twenty
13 years. *Id.* ¶ 43. The CHIPPENDALES Marks are distinctive, arbitrary, and
14 fanciful, and are entitled to the broadest scope of protection. *Id.* ¶ 24. In addition,
15 through the vast promotion and investment in the CHIPPENDALES brand,
16 combined with extensive publicity and sales under the CHIPPENDALES Marks,
17 Plaintiff has acquired enormous goodwill in the marks, and the CHIPPENDALES
18 Marks have become famous among the general public in the United States. *Id.* ¶ 26.

19 **D. Defendant's Counterfeit and Infringing Goods**

20 Defendant has no rights in the CHIPPENDALES Marks. Compl. ¶ 44.
21 Nevertheless, with actual and constructive knowledge of Plaintiff's rights,
22 Defendant has used counterfeits of Plaintiff's federally registered CHIPPENDALES
23 Marks, and marks that are substantially similar to those marks, to advertise and offer
24 for sale his own goods and services. *Id.* ¶¶ 48, 85-88.

25 For example, at Defendant's website located at *chippendalestruecrime.com*,
26 Defendant has offered for sale clothing and hats displaying spurious marks that are
27 identical with, or substantially indistinguishable from, Plaintiff's federally-



1 registered CHIPPENDALES Marks. Compl. ¶¶ 20, 88, 106-110. Defendant has
 2 also offered mobile phone cases and mugs bearing confusingly similar imitations of
 3 the CHIPPENDALES Marks through his website located at
 4 *chippendalestruecrime.com*. *Id.* ¶ 88. Defendant's counterfeit clothing and hats,
 5 and other infringing goods, are not manufactured, licensed, authorized, sponsored,
 6 endorsed, or approved by Plaintiff.

7 **E. Defendant's Infringing Services**

8 Defendant offers services in nightclub promotion, production of live shows
 9 for women, nightclub photography, and creative marketing under various
 10 CHIPPENDALES-formative marks that misrepresent his association with Plaintiff's
 11 CHIPPENDALES brand such that they are likely to cause confusion among
 12 consumers and are likely to cause the public to falsely associate Defendant with
 13 Plaintiff and its authentic CHIPPENDALES services. Compl. ¶ 89. For example,
 14 without authorization, Defendant advertises himself and his services using the
 15 infringing marks "**CHIPPENDALES HEIR**" and "**CHIPPENDALES**
 16 **AUTHORITY.**" *Id.* ¶¶ 90-92. Defendant also blatantly misrepresents himself as
 17 the "**CHIPPENDALES Chief Legal Strategist**," and the "**Strategic**
 18 **Administrator of the world name trademark, CHIPPENDALES.**" *Id.* ¶ 92.
 19 Further, in April 2023, Defendant filed articles of organization with the California
 20 Secretary of State to establish a limited liability company named "Chippendales
 21 LLC." *Id.* ¶ 93.

22 **F. Defendant's Misrepresentations to the U.S. Patent and Trademark
 23 Office**

24 Defendant has repeatedly attempted to assume control of Plaintiff's trademark
 25 registrations for its CHIPPENDALES Marks through the U.S. Patent and Trademark
 26 Office ("USPTO"). Compl. ¶¶ 49-51; 65-73. Beginning in 2016, and continuing in
 27 2022 and 2023, Defendant made several unauthorized filings with the USPTO, as



1 well as with the USPTO's Assignment Recordation Branch, attempting to change
 2 the ownership information of the CHIPPENDALES Marks from Plaintiff to an LLC
 3 established and controlled by Defendant, listing Defendant's personal mailing and
 4 email addresses for the owner contact information. *Id.* Defendant's unauthorized
 5 filings caused the USPTO to delete Plaintiff as the owner for many of its
 6 registrations and change the owner to Defendant's purported LLC. *Id.* ¶ 72. This
 7 cast a cloud over Plaintiff's title to its famous CHIPPENDALES Marks and
 8 imposed on Plaintiff a significant burden to correct the ownership records with the
 9 USPTO. *Id.* ¶ 73. Then, in December 2022, when trying to claim ownership of
 10 Plaintiff's U.S. Reg. No. 1197438 for the mark CHIPPENDALES in Class 41 (for
 11 "male dance exhibitions"), Defendant filed a specimen showing his use of that mark
 12 for "Chippendales male review, by the creator's first son. A new generation of
 13 entertainment. Fashion shows, country events, fair shows, and brand
 14 Ambassadors." *Id.* ¶ 68.

15 **G. Defendant's Probate Action Concerning the CHIPPENDALES
 16 Brand**

17 In 2017, Defendant filed a petition for probate in Los Angeles Superior Court,
 18 seeking authorization to open probate over the estate of Somen Banerjee, the
 19 founder of the CHIPPENDALES business, who died in 1994. Compl. ¶¶ 27, 52. In
 20 that proceeding, Defendant alleged that he is Somen's son and that certain persons
 21 have illegally withheld inheritance he is owed from Somen's estate. *Id.* ¶¶ 53-61.
 22 Plaintiff was not a party to that proceeding. On April 3, 2023, however, Defendant
 23 filed in the probate action a petition against Chippendales USA, LLC, titled
 24 "*Petition For: An Order Confirming USPTO Decision [sic] On Chippendales
 25 Trademark and All Series Partaining [sic] to Chippendales As Forming Part of the
 26 Estate of Somen Banerjee; Requesting § 859 Double Damages Against
 27 Chippendales USA, LLC*" ("Defendant's § 850 Petition"). Defendant's § 850 Petition



1 alleged that the CHIPPENDALES trademark was an asset of decedent Somen
 2 Banerjee that, after his death, was fraudulently sold by his wife Irene to CLP. *Id.* ¶
 3 76. Therefore, the Petition alleged, the sale of the CHIPPENDALES business and
 4 trademarks from CLP to Plaintiff was also fraudulent. *Id.* ¶ 77. In his § 850
 5 Petition, Defendant seeks the issuance of an order: a) “upholding the decision of the
 6 USPTO holding that the sale of the CHIPPENDALES trademark was fraudulent;”
 7 b) finding that the CHIPPENDALES trademark currently owned by Plaintiff is part
 8 of Mr. Somen Banerjee’s estate; c) transferring the CHIPPENDALES trademark
 9 owned by Plaintiff to Mr. Banerjee’s estate, as administered by Defendant; and d)
 10 restraining Plaintiff from using the CHIPPENDALES trademark. *Id.* ¶ 81.
 11 Chippendales USA, LLC removed the § 850 Petition to this Court, where it is
 12 pending as Case No. 2:23-cv-03676-PA.

13 **III. ARGUMENT**

14 Upon a defendant’s default, all well-pleaded allegations set forth in the
 15 complaint are deemed admitted. *See DIRECTV, Inc. v. Hoa Huynh*, 503 F.3d 847,
 16 851 (9th Cir. 2007); *Benny v. Pipes*, 799 F.2d 489, 495 (9th Cir. 1986) (upholding a
 17 default judgment because well-pleaded factual allegations must be taken as true
 18 given a party’s failure to answer).

19 **A. The *Eitel* Factors Favor Entry of Default Judgment**

20 Pursuant to Federal Rule of Civil Procedure 55(b), a court may enter default
 21 judgment following entry of default. *See PepsiCo, Inc. v. Cal. Sec. Cans*, 238 F.
 22 Supp. 2d 1172, 1174 (C.D. Cal. 2002).¹ A defaulting defendant is deemed to have
 23 admitted all well-pleaded factual allegations in the complaint related to liability.

24
 25 ¹ This Court has original jurisdiction over the subject matter of this action
 26 pursuant to 28 U.S.C. §§ 1331, 1338(a) & 1338(b), and 15 U.S.C. § 1121.
 27 Defendant is subject to personal jurisdiction because he resides in and conducts
 28 business within this District, and he has committed acts of trademark infringement,
 29 counterfeiting, and unfair competition within the state of California and this District.



1 *DIRECTV, Inc.*, 503 F.3d at 851.

2 Rule 55(b)(2) grants the Court discretion to enter a judgment by default
 3 against any party that fails to plead or otherwise defend as required by the rules.
 4 *Philip Morris USA Inc. v. Castworld Prods., Inc.*, 219 F.R.D. 494, 498 (C.D. Cal.
 5 2003). The Ninth Circuit has identified seven factors courts should consider in
 6 deciding whether to enter default judgment:

7 (1) the possibility of prejudice to the plaintiff, (2) the merits of plaintiff's
 8 substantive claim, (3) the sufficiency of the complaint, (4) the sum of
 9 money at stake in the action; (5) the possibility of a dispute concerning
 10 material facts; (6) whether the default was due to excusable neglect, and
 11 (7) the strong policy underlying the Federal Rules of Civil Procedure
 12 favoring decisions on the merits.

13 *Eitel v. McCool*, 782 F.2d 1470, 1471-72 (9th Cir. 1986). "In applying this
 14 discretionary standard, default judgments are more often granted than denied."
 15 *Elektra Entm't Grp. Inc. v. Crawford*, 226 F.R.D. 388, 392 (C.D. Cal. 2005). As
 16 discussed below, the *Eitel* factors strongly favor entry of default judgment in favor
 17 of Plaintiff.

18 **1. Plaintiff Will Be Prejudiced Absent a Default Judgment**

19 The prejudice factor favors entry of default judgment where, as here, the
 20 absence of a default judgment would leave the plaintiff without another recourse for
 21 recovery. *See Levi Strauss & Co. v. Toyo Enter. Co.*, 665 F. Supp. 2d 1084, 1095
 22 (N.D. Cal. 2009) (first *Eitel* factor favored default judgment where plaintiff
 23 otherwise would be "unable to prevent continued infringement"). Despite being
 24 served with the Summons and Complaint by two different means of service (*see*
 25 Dkt. 17), as well as being served with Plaintiff's request to the Clerk of Court to
 26 enter default against Defendant (*see* Dkt. 21) and the actual entry of default (*see*
 27 Dkt. 22), Defendant has failed to respond or otherwise appear in this action.



1 Nevertheless, Defendant continues to make unauthorized uses of Plaintiff's marks.
 2 Nadel Decl. ¶¶ 17-19. Accordingly, Plaintiff has no other recourse to stop
 3 Defendant's continued infringement, and the first *Eitel* factor weighs strongly in
 4 favor of a default judgment. *See Vietnam Reform Party v. Viet Tan - Vietnam*
 5 *Reform Party*, 416 F. Supp. 3d 948, 962 (N.D. Cal. 2019) (finding plaintiff would be
 6 prejudiced absent a default judgment because it would have no other recourse to
 7 prevent infringement).

8 **2. Plaintiff's Complaint is Sufficiently Pled and Its Claims Are
 9 Meritorious**

10 "Under the second and third *Eitel* factors the Court must examine whether the
 11 Plaintiff has pled facts sufficient to establish and succeed upon its claims."
 12 *Craigslist, Inc. v. Naturemarket, Inc.*, 694 F. Supp. 2d 1039, 1055 (N.D. Cal. 2010).
 13 Plaintiff has pled facts—deemed admitted by virtue of Defendant's default—
 14 sufficient to establish and succeed upon each of its seven causes of action. *See*
 15 *DIRECTV, Inc.*, 503 F.3d at 851 ("[I]n defaulting, defendants are deemed to have
 16 admitted all well-pleaded factual allegations contained in the complaints.").

17 **a. Plaintiff's Federal Claims for Trademark Infringement
 18 and Unfair Competition, and its California Claim for
 19 Unfair Competition**

20 "[C]laims for trademark infringement [and] unfair competition under federal
 21 law, and unfair competition under California law are all 'subject to the same legal
 22 standards.'" *Kinsley Tech. Co. v. Ya Ya Creations, Inc.*, No. 2:20-CV-04310-ODW-
 23 KSx, 2022 WL 3908831, at *3 (C.D. Cal. Aug. 30, 2022) (citation omitted). To
 24 succeed on these claims, a plaintiff must prove that: "(1) it has a protectable
 25 ownership interest in the mark; and (2) the defendant's use of the mark is likely to
 26 cause consumer confusion." *Network Automation, Inc. v. Advanced Sys. Concepts,*
 27 *Inc.*, 638 F.3d 1137, 1144 (9th Cir. 2011).

i. Plaintiff's Protectable Ownership Interest in the CHIPPENDALES Marks

3 Plaintiff has adequately alleged a valid ownership interest in the
4 CHIPPENDALES Marks. Plaintiff owns federal registrations for the
5 CHIPPENDALES Marks (Compl. ¶¶ 20-26, 98-99), which constitute “prima facie
6 evidence of the validity” of those marks and Plaintiff’s ownership of them. *Kinsley*
7 *Tech. Co.*, 2022 WL 3908831, at *4 (quoting 15 U.S.C. § 1115(a)). Further,
8 Plaintiff’s incontestable registrations² for the majority of the CHIPPENDALES
9 Marks constitute “conclusive evidence” of the validity of those marks and of
10 Plaintiff’s ownership of them. *See KP Permanent Make-Up, Inc. v. Lasting*
11 *Impression I, Inc.*, 543 U.S. 111, 117 (2004); 15 U.S.C. § 1115(b).

ii. **Defendant's Unauthorized Use of the CHIPPENDALES Marks Is Likely to Cause Confusion**

15 Plaintiff has adequately alleged that Defendant's use of the CHIPPENDALES
16 Marks and confusingly similar imitations of them is likely to cause consumer
17 confusion. For example, Defendant has used Plaintiff's exact marks on Defendant's
18 website to sell goods that copy "the color scheme, layout, and design features of
19 Plaintiff's authentic CHIPPENDALES merchandise." Compl. ¶ 87-88. Defendant
20 also uses confusingly similar imitations of the CHIPPENDALES Marks to offer
21 "services in nightclub promotion, production of live shows for women, nightclub
22 photography, and creative marketing"—all services nearly identical to Plaintiff's
23 legitimate CHIPPENDALES services. *Id.* ¶¶ 89-91. Such conduct "has caused" and
24 "will continue to cause, a likelihood of confusion and deception of members of the
25 trade and public." *Id.* ¶ 100.

² U.S. Reg. Nos. 1197438; 1330855; 2802430; 3127649; 3690717; and 3981590.



Accordingly, Plaintiff has pled facts sufficient to establish and succeed upon its federal claims for trademark infringement and unfair competition, and its California claim for unfair competition.

b. Plaintiff's Federal Counterfeiting Claim

A federal counterfeiting claim is subject to the same standards as a federal trademark infringement claim, except that the defendant's mark must "be (1) a non-genuine mark identical^[3] to the registered, genuine mark of another, where (2) the genuine mark was registered for use on the same goods to which the infringer applied the mark." *Louis Vuitton Malletier, S.A. v. Akanoc Sols., Inc.*, 658 F.3d 936, 946 (9th Cir. 2011).

Here, Plaintiff owns a registration for CHIPPENDALES in connection with “hats” and “t-shirts” (U.S. Reg. No. 3127649), and Defendant has used a substantially indistinguishable version of that mark in connection with the sale of hats and t-shirts. Compl. ¶¶ 87-88, 106; Nadel Decl. Ex. 2. Plaintiff also owns a registration for the CHIPPENDALES & Bow Tie Design mark in connection with “hats” and “t-shirts” (U.S. Reg. No. 5203733), and Defendant has used a substantially indistinguishable version of that mark in connection with the sale of hats and t-shirts. Compl. ¶¶ 87-88, 106; Nadel Decl. Ex. 3.

Accordingly, Plaintiff has pled facts sufficient to establish and succeed upon its federal counterfeiting claim.⁴ *See, e.g., Phillip Morris USA Inc. v. Shalabi*, 352

³ The defendant's mark may alternatively be "substantially indistinguishable from" the plaintiff's registered mark. 15 U.S.C. § 1127.

⁴ Moreover, in support of its request for statutory damages, Plaintiff has filed with its Motion detailed website evidence showing Defendant's multiple unauthorized uses of Plaintiff's CHIPPENDALES marks, which confirm the uncontested allegations in Plaintiff's Complaint. *See Nestle USA, Inc. v. Gunther Grant, Inc.*, No. CV-13-6754 MMM (ASX), 2014 WL 12558008, at *13 (C.D. Cal. May 13, 2014) (granting default judgment; in addition to the allegations in complaint being taken as true due to entry of default, plaintiff's provision of website screenshots and

1 F. Supp. 2d 1067, 1073 (C.D. Cal. 2004) (in cases involving counterfeit marks, “it is
 2 unnecessary to perform the step-by-step examination . . . because counterfeit marks
 3 are inherently confusing.”) (citation omitted).

4 **c. Plaintiff’s Federal and State Law Dilution Claims**

5 Plaintiff has also established that Defendant’s actions constitute trademark
 6 dilution under both federal and California law. The requirements for each are the
 7 same. *See Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 634 (9th Cir. 2008). To
 8 prevail on a dilution claim, a plaintiff must show that: (1) its mark is famous; (2) the
 9 defendant began using its mark after the Plaintiff’s mark became famous; and (3)
 10 the defendant’s use is likely to cause dilution by blurring or dilution by tarnishment.
 11 *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158, 1172 (9th
 12 Cir. 2011); 15 U.S.C. § 1125(c); Cal. Bus. & Prof. Code § 14330.

13 The CHIPPENDALES Marks are famous because (1) they have been in use
 14 since 1979; (2) they have long been “a cultural phenomenon”; (3) they are the
 15 subject of numerous federal registrations; (4) Plaintiff and its predecessors “have
 16 invested enormous amounts of time, money, and effort advertising and promoting”
 17 CHIPPENDALES-branded products and services “throughout the United States”;
 18 (5) they are the subject of “extensive publicity and sales”; and (6) they “are
 19 recognized . . . throughout the United States by consumers.” Compl. ¶¶ 12, 14-20,
 20 25-26, 118, 124.

21 The CHIPPENDALES Marks became famous “well before Defendant began”
 22 using “confusingly similar CHIPPENDALES marks.” Compl. ¶ 118. And
 23 Defendant’s actions “are likely to dilute the distinctiveness of Plaintiff’s famous
 24 CHIPPENDALES [Marks] by eroding the public’s exclusive identification of those
 25 famous marks with Plaintiff, tarnishing and degrading the positive associations of

26
 27 images of defendant’s infringement negated possibility that material facts were
 28 disputed).

1 those famous marks, and otherwise lessening the capacity of the CHIPPENDALES
 2 [Marks] to identify and distinguish Plaintiff's goods and services." *Id.* ¶ 119.

3 Therefore, Plaintiff has pled facts sufficient to establish and succeed upon its
 4 federal and state-law dilution claims.

5 **d. Plaintiff's Declaratory Judgment Claim**

6 Finally, Plaintiff has established that a "case of actual controversy" exists
 7 between the parties to warrant the issuance of a declaratory judgment, and that
 8 Plaintiff is entitled to a judicial determination and declaration of its rights with
 9 respect to the ownership of the CHIPPENDALES Marks. 28 U.S.C. § 2201. The
 10 Declaratory Judgment Act allows a federal court to "declare the rights and other
 11 legal relations" of parties to a "case of actual controversy." *Id.* "The two principal
 12 criteria guiding the policy in favor of rendering declaratory judgments are (1) when
 13 the judgment will serve a useful purpose in clarifying and settling the legal relations
 14 in issue, and (2) when it will terminate and afford relief from the uncertainty,
 15 insecurity, and controversy giving rise to the proceeding." *Vietnam Reform Party*,
 16 416 F. Supp. 3d at 969.

17 Defendant's actions online, before the USPTO, and in the courthouse have
 18 created an actual, substantial, and immediate controversy between the parties
 19 regarding Plaintiff's ownership of the CHIPPENDALES Marks such that the
 20 issuance of a declaratory judgment "will clarify Plaintiff's rights regarding the
 21 Marks and resolve the controversy." *See id.*

22 The uncontested facts establish that Defendant has repeatedly claimed that
 23 Plaintiff's 2000 purchase of the CHIPPENDALES business, the CHIPPENDALES
 24 Marks, and all goodwill associated with the marks, was "fraudulent," and thus the
 25 CHIPPENDALES Marks belong to the estate of the late Steve Banerjee, and
 26 ultimately to Defendant as an alleged "heir" of the estate. Compl. ¶¶ 46-47, 49-50,
 27 62, 66-67, 74-78, 81, 95. Defendant has repeatedly made such contentions in

1 unauthorized filings for Plaintiff's trademarks that he has submitted to the USPTO,
 2 attempting to change the owner from Plaintiff to Defendant. *Id.* ¶¶ 46, 49-51, 65-73,
 3 95. Moreover, Defendant has made those claims in a petition he filed against
 4 Plaintiff in a probate proceeding before Los Angeles Superior Court regarding the
 5 estate of Mr. Somen Banerjee.⁵ In that petition, Jesse Banerjee requested a judicial
 6 order: (a) "upholding the decision of the USPTO holding that the sale of the
 7 CHIPPENDALES trademark was fraudulent"; (b) finding that the
 8 CHIPPENDALES trademark currently owned by Plaintiff is part of Mr. Somen
 9 Banerjee's estate; (c) transferring the CHIPPENDALES trademark owned by
 10 Plaintiff to Mr. Somen Banerjee's estate, as administered by Defendant; and (d)
 11 restraining Plaintiff from using the CHIPPENDALES trademark. *Id.* ¶¶ 74-81.

12 Because Defendant's actions have created a "case of actual controversy,"
 13 Plaintiff is entitled to a declaratory judgment recognizing its exclusive ownership of
 14 the CHIPPENDALES Marks (as reflected in Plaintiff's Proposed Judgment and
 15 Permanent Injunction, filed with this Motion). Therefore, Plaintiff has sufficiently
 16 pled and can prevail on its claim for declaratory judgment.

17 Based on the foregoing, the second and third *Etel* factors weigh in favor of
 18 entry of default judgment in Plaintiff's favor on all of its claims.

19 **3. The Damages Sought By Plaintiff Favor Default Judgment**

20 The fourth *Etel* factor involves consideration of the amount of money at
 21 stake. *Etel*, 782 F.2d at 1471-72. As discussed in more detail below (*see infra* pp.
 22 20-21), due to Defendant's failure to appear in this action, it is impossible to
 23 determine Defendant's profits or Plaintiff's actual damages, and thus Plaintiff seeks

24
 25 ⁵ On May 12, 2023, Chippendales removed Mr. Banerjee's Petition to this Court
 26 based on diversity of citizenship and because the Petition is adversarial in nature,
 27 qualifying as a civil action properly removable within the meaning of 28 U.S.C. §
 28 1441(b). That related case is *Jesse Banerjee v. Chippendales USA, LLC*, Case No.
 2:23-cv-03676-PA (PDx).

1 an award of statutory damages for Defendant's counterfeiting. Plaintiff, however, is
 2 not seeking anywhere near the maximum amount of statutory damages to which it is
 3 entitled under the Lanham Act.

4 The Lanham Act authorizes statutory damages of up to \$2,000,000 *per*
 5 counterfeit mark *per* type of goods or services sold, 15 U.S.C. § 1117, meaning
 6 Plaintiff could potentially recover millions of dollars in statutory damages. But
 7 Plaintiff is only seeking \$25,000 per mark, for a total of \$50,000. *See infra* pp. 20-
 8 21. Because this amount falls far below the statutory maximum set by Congress,
 9 this *Eitel* factor favors the entry of default judgment. *See Nestle USA, Inc. v.*
 10 *Gunther Grant, Inc.*, No. CV-13-6754 MMM (ASX), 2014 WL 12558008, at *12
 11 (C.D. Cal. May 13, 2014) (fourth *Eitel* factor "d[id] not weigh against the entry of
 12 default judgment" even where plaintiff sought \$2,100,000 in statutory damages—
 13 the maximum allowed); *see also Tech. LED Intellectual Prop., LLC v. Recogi, LLC*,
 14 No. 18-cv-3827, 2019 WL 2716610, at *4 (N.D. Cal. June 27, 2019) ("[D]efault
 15 judgment is appropriate where [the amount] is 'tailored to [the defendant's] specific
 16 misconduct.'").

17 **4. No Dispute Exists As To Material Facts**

18 The factual allegations in the Complaint, which must be accepted as true, also
 19 include "screenshots and images that depict defendants' use of [Plaintiff's] marks,"
 20 and Plaintiff has provided proof of "service on defendants of the summons and
 21 complaint in this action." *See Nestle USA, Inc.*, 2014 WL 12558008, at *12.
 22 "[T]hus, there is no dispute that defendants infringed," and "[t]his factor, therefore,
 23 also favors the entry of default judgment against defendant[]." *See id.*

24 **5. The Default Entered Against Defendant Did Not Result from**
 25 **Excusable Neglect**

26 The sixth *Eitel* factor, whether the default "may have been the product of
 27 excusable neglect," favors default judgment "when the defendant has been properly
 28

1 served or the plaintiff demonstrates that the defendant is aware of the lawsuit.”
 2 *Wecosign, Inc. v. IFG Holdings, Inc.*, 845 F. Supp. 2d 1072, 1082 (C.D. Cal. 2012).
 3 Service was properly effected on Defendant. Dkt. 17; Nadel Decl. ¶ 5. Mr.
 4 Banerjee is also the plaintiff in a related action in this Court, in which a number of
 5 filings have explicitly referred to this case. *See Banerjee v. Chippendales USA LLC*,
 6 Case No. 2:23-cv-03676-PA, Dkt. Nos. 1, 10, 25, 27-1, 29. Under such
 7 circumstances, even though Defendant may be *pro se*, no basis exists to conclude
 8 that Defendant’s default was the result of excusable neglect. *See PepsiCo, Inc.*, 238
 9 F. Supp. 2d at 1177 (“Given [*pro se*] Defendant’s early participation in the matter,
 10 the possibility of excusable neglect is remote.”); *see also Deckers Outdoor Corp. v.*
 11 *Granger*, No. 2:10-CV-06476-JHN-MANx, 2011 WL 13217386, at *2 (C.D. Cal.
 12 Feb. 24, 2011) (“Defendant submitted a letter to the Court on September 29, 2010 to
 13 which the Court responded, referring her to the Pro Se Clinic for assistance. Thus,
 14 Defendant’s failure to respond to this lawsuit was not due to excusable neglect.”).

15 **6. Defendant’s Failure to Answer Makes a Decision on the
 16 Merits Impossible**

17 The final *Eitel* factor balances the entry of default judgment against the
 18 preference for deciding cases on the merits. *Eitel*, 782 F.2d at 1472. Because
 19 Defendant’s failure to answer makes a decision on the merits impractical, if not
 20 impossible, *see Philip Morris USA Inc.*, 219 F.R.D. at 501, entry of default is
 21 warranted here. *See PepsiCo., Inc.*, 238 F. Supp. 2d at 1177.

22 **7. Summary of the *Eitel* Factors**

23 Each of the *Eitel* factors favors granting Plaintiff’s motion for default judgment
 24 against Defendant. Accordingly, a default judgment is proper.

25
 26
 27
 28



B. Plaintiff's Requested Remedies are Warranted, Authorized, and Substantiated

1. Plaintiff is Entitled to Injunctive Relief

Plaintiff seeks to permanently enjoin Defendant from counterfeiting and infringing its CHIPPENDALES Marks. *See* Proposed Judgment and Permanent Injunction, filed concurrently. The requested injunction, which is consistent with what Plaintiff prayed for in its Complaint (*see* Complaint ¶¶ 7-10) is both authorized by the relevant statutes and warranted under the facts of this case.

The Lanham Act expressly authorizes injunctive relief where a defendant engages in trademark infringement, counterfeiting, trademark dilution, or unfair competition. *See* § 1116(a). Indeed, “[i]njunctive relief is the remedy of choice for trademark and unfair competition cases, since there is no adequate remedy at law for the injury caused by a defendant’s continuing infringement.” *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1180 (9th Cir. 1988). Plaintiff is also entitled to an injunction based on Defendant’s conduct constituting trademark dilution and unfair trade practices under California law. *See* Cal. Bus. & Prof. Code §§ 14247, 14330.

As discussed above, Plaintiff has shown that it is entitled to judgment on each of its claims. There is no dispute that Plaintiff will continue to suffer irreparable harm if a permanent injunction does not issue. The undisputed facts establish that Plaintiff has suffered, and will continue to suffer, irreparable harm by virtue of Defendant’s intentional acts of infringement, counterfeiting, unfair competition, and dilution unless Defendant is enjoined. *See* Compl. ¶¶ 103, 111, 116, 121, 126, 130.

2. Plaintiff is Entitled to a Declaratory Judgment

As discussed above (*see supra* pp. 14-15), Plaintiff has established that a sufficient “case of actual controversy” exists between the parties to warrant the issuance of a declaratory judgment, and that Plaintiff is entitled to a judicial

1 determination and declaration of the rights of the parties with respect to the
 2 ownership of the CHIPPENDALES Marks. A declaratory judgment is particularly
 3 appropriate here, as Defendant has repeatedly tried to seize control of Plaintiff's
 4 CHIPPENDALES trademark registrations at the USPTO, and has even filed a civil
 5 action against Plaintiff requesting that Plaintiff be enjoined from using its
 6 CHIPPENDALES Marks, and that ownership of the marks is transferred to
 7 Defendant.

8 Therefore, Plaintiff respectfully requests that the Court issue a declaratory
 9 judgment containing a determination of the parties' rights with respect to the
 10 CHIPPENDALES Marks, in substantially the same form as contained in Plaintiff's
 11 Proposed Judgment and Permanent Injunction, filed concurrently. Specifically,
 12 Plaintiff is entitled to a judgment declaring that:

- 13 1) The March 30, 2000, sale of the CHIPPENDALES business,
 14 CHIPPENDALES Marks, and the associated goodwill from CLP Tour,
 15 Ltd. to plaintiff Chippendales USA, LLC, was valid and binding;
- 16 2) Chippendales USA, LLC is the rightful and exclusive owner of common
 17 law and registered rights in the CHIPPENDALES Marks, as it acquired
 18 from CLP Tour, Ltd. on March 30, 2000;
- 19 3) Plaintiff is the rightful and exclusive owner of common law and registered
 20 rights in the CHIPPENDALES Marks, as acquired by its more than 20
 21 years of exclusive and continuous use of the marks;
- 22 4) Jesse Banerjee has no rights or legitimate interest in the CHIPPENDALES
 23 Marks or any marks or domain names confusingly similar thereto;
- 24 5) Easebe Enterprises, Inc., incorporated in California by Somen Banerjee on
 25 August 29, 1975, has no rights or legitimate interest in the
 26 CHIPPENDALES Marks or any marks or domain names confusingly
 27 similar thereto;

- 1 6) Easebe Enterprises, Inc., incorporated in California by Defendant on
 2 January 1, 2017; has no rights or legitimate interest in the
 3 CHIPPENDALES Marks or any marks or domain names confusingly
 4 similar thereto;
- 5 7) The estate of Somen Banerjee has no rights or legitimate interest in the
 6 CHIPPENDALES Marks or any marks or domain names confusingly
 7 similar thereto; and
- 8 8) Jesse Banerjee's unauthorized use of the CHIPPENDALES Marks
 9 constitutes federal trademark infringement, federal trademark
 10 counterfeiting, federal unfair competition, federal trademark dilution,
 11 California trademark dilution, and unfair business practices under
 12 California Business & Professions Code § 17200 *et seq.*

13 **3. Plaintiff is Entitled to Statutory Damages**

14 The Lanham Act provides statutory damages for the use of counterfeit marks
 15 in the amount of \$1,000 to \$200,000 per counterfeit mark, per type of goods or
 16 services—an amount which may be increased in cases of willful counterfeiting to
 17 \$2,000,000 per mark, per type of goods or services. *See* 15 U.S.C. § 1117(c)).
 18 Here, “Defendant’s actions demonstrate an intentional, willful, and malicious intent
 19 to trade on the goodwill of Plaintiff’s CHIPPENDALES [Marks].” Compl. ¶¶ 101,
 20 115, 120. At default judgment, “all factual allegations in the complaint are deemed
 21 true, including” allegations of “willful infringement.” *Derek Andrew, Inc. v. Poof*
 22 *Apparel Corp.*, 528 F.3d 696, 702 (9th Cir. 2008).

23 As discussed in Section III.A.2.b. *supra*, Defendant willfully used at least two
 24 counterfeit marks in connection with hats and t-shirts, and Plaintiff is therefore
 25 entitled to up to \$8,000,000 in statutory damages. But here, Plaintiff requests an
 26 award of \$25,000 per mark, for a total of **\$50,000** in statutory damages. This
 27 amount bears a plausible relationship to Plaintiff’s actual damages—including the

1 diminution in the value of the CHIPPENDALES Marks and harm to Plaintiff's
 2 reputation—and is sufficient to deter future infringement. *See Rolex Watch U.S.A.,*
 3 *Inc. v. LSM Watch, Inc.*, No. CV 21-1612-PSG (SKx), 2022 WL 3575771, at *7
 4 (C.D. Cal. June 7, 2022) ("\$1 million per counterfeited mark is necessary to deter
 5 Defendants and others from counterfeiting Plaintiff's registered trademarks, even if
 6 Defendants' actual ill-gotten gains were likely less than half of that sum").
 7 Plaintiff's requested amount of statutory damages is extremely reasonable in light of
 8 Defendant's refusal to participate in this case and the statutory damages available
 9 for willful counterfeiting.

10 **4. Plaintiff Is Entitled to Attorneys' Fees And Costs**

11 Finally, Plaintiff is entitled to an award of its attorneys' fees and costs it
 12 expended in pursuit of this action. The Lanham Act authorizes recovery of "costs"
 13 in all cases, and recovery of attorneys' fees in "exceptional cases." 15 U.S.C. §
 14 1117(a). The Ninth Circuit has twice held that an allegation of willful infringement
 15 "deemed true" through default "sufficiently establishes [a plaintiff's] entitlement to
 16 attorneys' fees under the Lanham Act." *Derek Andrew, Inc.*, 528 F.3d at 702; *Rio*
 17 *Props., Inc. v. Rio Int'l Interlink*, 284 F.3d 1007, 1023 (9th Cir. 2002). As discussed
 18 above, Defendant's conduct was willful, deliberate, and malicious, making this an
 19 exceptional case under the Lanham Act. *See YYGM S.A. v. Palco Clothing, Inc.*, No.
 20 CV 15-9181 PA (JRPx), 2016 WL 7655755, at *3 (C.D. Cal. June 20, 2016)
 21 (Anderson, J.) ("[G]iven the Complaint's well-pleaded allegations of willful
 22 infringement, this is an exceptional case under the Lanham Act.").

23 Accordingly, Defendant should be required to pay the attorneys' fees and
 24 costs expended by Plaintiff in pursing this action to redress Defendant's willful
 25 infringement. Pursuant to L.R. 55-3, and because Plaintiff seeks \$50,000 in
 26 statutory damages, Plaintiff seeks "\$1200 plus 6% of [\$40,000]," or **\$3,600** in
 27 attorney's fees. Plaintiff is prepared to submit detailed documents showing that

1 Plaintiff has incurred and paid significantly more than \$3,600 in fees.

2 **IV. CONCLUSION**

3 For the foregoing reasons, Plaintiff respectfully requests that the Court grant
4 Plaintiff's Motion for Entry of Default Judgment, permanently enjoin Defendant,
5 issue a declaratory judgment, and award Plaintiff statutory damages, attorneys' fees,
6 and costs, as detailed in the Proposed Judgment and Permanent Injunction submitted
7 with this Motion.

8 Dated: July 19, 2023

9 Respectfully submitted,

10 KILPATRICK TOWNSEND & STOCKTON LLP

11 By: /s/ Evan S. Nadel
12 EVAN S. NADEL

13 *Attorneys for Plaintiff*
14 *Chippendales USA, LLC*



Local Rule 11-6.2 Certificate of Compliance

The undersigned, counsel of record for Plaintiff Chippendales USA, LLC, certifies that this brief contains 6,143 words, which complies with the word limit of L.R. 11-6.1.

Dated: July 19, 2023

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

By: /s/ Evan S. Nadel
EVAN S. NADEL

*Attorneys for Plaintiff
Chippendales USA, LLC*



PLAINTIFF'S MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF ITS
MOTION FOR ENTRY OF DEFAULT JUDGMENT AGAINST DEFENDANT
Case No.: 2:23-cv-03672 PA (PDx)